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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,434	09/10/2001	Peter Sauerbrei	49658-0512	1649

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Moser Patterson & Sheridan
3040 Post Oak Boulevard
Suite 1500
Houston, TX 77056-6582

EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2628

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

31

Office Action Summary	Application No.	Applicant(s)	
	09/955,434	SAUERBREI, PETER	
	Examiner	Art Unit	
	Jeffery A. Brier	2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-6, 8-32, 34-37, 39-55, 57, and 63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 8-32, 34-37, 39-55, 57 and 63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>20060822</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. The amendment filed on 6/5/2006 has been entered.

Response to Arguments

2. Applicant's comments filed on 6/5/2006 concerning the telephone interview are noted. It should be noted the interview was held on 6/5/2006 rather than 6/6/2006 and noted this amendment was filed on 6/5/2006.
3. Applicant's arguments filed 6/5/2006 have been fully considered but they are not persuasive because the amendments made to claims 1, 32, 55, and 57 do not add a concrete, useful, and tangible result to these claims. The arguments concerning claim 57 are not persuasive because the means plus function language does not exclude the nonstatutory disclosed means of the specification. Regarding claims 32, 34-37, and 39-54 the term "tangible" does not exclude the claim from claiming a carrier wave as described hereinafter, or any other medium from which a computer can read as disclosed at page 8 line 27 to page 9 line 4. A carrier wave would appear to be a tangible computer readable medium to a computer's wireless receiver.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 63 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This new claim claims in the last line "displaying the established locations for the objects" but does not claim how they are displayed, thus, this claim is claiming something different than that which is discussed at page 32 line 22 to page 33 line 2 which discusses displaying the objects onto the constraint and discusses alternatively displaying the constraint but does not discuss displaying the established location for the objects.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1, 3-6, 8-32, 34-37, 39-55, 57, and 63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 32, 34-37, 39-54, and 57:

These claims claim carrier wave signals as a tangible computer readable medium because applicants specification at page 8 lines 23-25, page 9 line 3, and page 10 lines 8 and 17 defines tangible computer readable medium as carrier wave. A

carrier wave would appear to be a tangible computer readable medium to a computer's wireless receiver. The claims need to exclude the disclosed "transmission media" which is disclosed as acoustic or light waves.

Page 8 lines 17-25 states (emphasis added with underlining):

The term "computer-readable medium" as used herein refers to any medium that participates in providing instructions to processor 204 for execution. Such a medium may take many forms, including but not limited to, non-volatile media, volatile media, and transmission media. Non-volatile media includes, for example, optical or magnetic disks, such as storage device 210. Volatile media includes dynamic memory, such as main memory 206. Transmission media includes coaxial cables, copper wire and fiber optics, including the wires that comprise bus 202. Transmission media can also take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications.

Page 8 line 27 to page 9 line 4 states (emphasis added with underlining):

Common forms of computer-readable media include, for example, a floppy disk, a flexible disk, hard disk, magnetic tape, or any other magnetic medium, a CD-ROM, any other optical medium, punch cards, paper tape, any other physical medium with patterns of holes, a RAM, a PROM, and EPROM, a FLASH-EPROM, any other memory chip or cartridge, a carrier wave as described hereinafter, or any other medium from which a computer can read.

Page 9 line 26 to page 10 line 8 states (emphasis added with underlining):

Network link 220 typically provides data communication through one or more networks to other data devices. For example, network link 220 may provide a connection through local network 222 to a host computer 224 or to data equipment operated by an Internet Service Provider (ISP) 226. ISP 226 in turn provides data communication services through the world wide packet data communication network now commonly referred to as the "Internet" 228. Local network 222 and Internet 228 both use electrical, electromagnetic or optical signals that carry digital data streams. The signals through the various networks and the signals on network link 220 and through communication interface 218, which carry the digital data to and from computer system 200, are exemplary forms of carrier waves transporting the information.

Page 10 line 15-17 states (emphasis added with underlining):

The received code may be executed by processor 204 as it is received, and/or stored in storage device 210, or other non-volatile storage for later execution. In this

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manner, computer system 200 may obtain application code in the form of a carrier wave.

Therefore, the specification defines computer readable medium as a carrier wave.

Thus, when the claims are read in light of the specification claims 32, 34-37, 39-54, and 57 claim a carrier wave computer readable medium. In ANNEX IV Computer-Related Nonstatutory Subject Matter of the Interim guidelines a signal is held to be nonstatutory subject matter and since applicants carrier wave is a signal then these claims are nonstatutory.

Means plus function claim 57 is included because the means in the claim, in view of the specification, is the computer readable medium which has been defined as a carrier wave which is a signal.

Claims 1, 3-6, 8-32, 34-37, 39-55, and 57:

These claims fail to claim a useful, tangible, and concrete result. Each of claims 1, 32, 55, and 57 as a whole and their respective last two steps "mapping the set of points to the defined constraint to establish location of the objects relative to said constraint" and "storing the established locations for the objects" do not manifest a useful, tangible, and concrete result. Storing the established location is not useful to the user since he does not use these results. Thus, these claims as well as their dependent claims need an additional step (or means plus function step in claim 57) that manifest a useful, tangible, and concrete result. The specification at page 32 line 26 to page 33 line 2 states:

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At step 814, the constraint is displayed and objects placed onto the constraint at the object locations that were determined in step 812. In other embodiments, the objects are not displayed on the constraint. For example, the generated set of points may be returned to a unit of software that is interfacing with the spacing mechanism

Thus, a display step would be one way applicant could meet the useful, tangible, and concrete result requirement.

Claim 63:

This claim is nonstatutory because the claimed “displaying the established location for the objects” does not claim displaying the objects at the established locations nor does it claim any particular method of displaying a location, thus, displaying the established location does not give the user a useful, tangible, and concrete result.

Claim 57:

This claim is additionally nonstatutory because this means plus function claim has its “means”, due to alternative definitions in the specification, as being software or software module which is nonstatutory since a program per se is not statutory.

Applicants specification at page 8 lines 13-16 defines software as an alternative to hardware and as an alternative to hardware and software combination and states:

In alternative embodiments, hard-wired circuitry may be used in place of or in combination with software instructions to implement the invention. Thus, embodiments of the invention are not limited to any specific combination of hardware circuitry and software.

Applicant should note that amendments to the specification, such as deletion, may introduce new matter into the specification. Thus, an appropriate amendment to the claims is necessary to make the claims statutory.

Allowable Subject Matter

8. Claims 1, 3-6, 8-32, 34-37, 39-55 and 57 would be allowable if the claims can be amended to overcome the 35 USC 101 nonstatutory rejection. Applicant remarks concerning Takakura et al. at pages 14-16 of the 9/27/2005 response are persuasive to overcome the 103 rejection of Asente in view of Takakura et al.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-

7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffery A Brier
Primary Examiner
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